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JUN 15 2007

TECHNOLOGY CENTER 3600

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In re Application of  
Jay S. Walker et al.  
Application No. 09/605,818  
Filed: June 28, 2000  
For: SYSTEM FOR UTILIZING  
REDEMPTION INFORMATION

On Petition to  
WITHDRAW SUPPLEMENTAL  
EXAMINER'S ANSWER  
under  
37 CFR 1.181

This is a decision on Appellant's Petition under 37 CFR 1.181 filed on December 18, 2006 to withdraw the Supplemental Examiner's Answer mailed November 28, 2006.

The petition is **DENIED**.

Issues Raised on Petition and Relief Sought

The Petition alleges that the Examiner impermissibly filed the Supplemental Examiner's Answer mailed November 28, 2006 because such Supplemental Examiner's Answer was responding to "new arguments" rather than "new issues". The Petition argues that "new arguments" in a Reply Brief are insufficient to warrant the filing of a Supplemental Examiner's Answer and that the Reply Brief filed August 15, 2006 did not raise any "new issues". Petitioner cites 37 CFR 41.43(a)(1) and MPEP 1207.05(I) in support of this Petition. Petitioner seeks withdrawal of the Supplemental Examiner's Answer mailed November 28, 2006.

History

Office action mailed September 13, 2005: The Examiner provided documentary evidence in the form of Lough, Kerch, and Broshy in support of items Officially Noticed in the Office action mailed April 6, 2005.

Appeal Brief filed March 9, 2006: Appellant alleged (at page 23) that the Examiner had misconstrued the phrase "comparable sales" in Lough (i.e. to include both properties that are for sale and properties that have already sold). To this end, Appellant argued that the term "sales" in Lough "refers to properties that are offered for sale, not those that have already sold" (emphasis added).

Examiner's Answer mailed June 15, 2006: The Examiner, in response to the Appeal Brief, responded to the allegation that he had misconstrued the phrase "comparable sales". To this end, the Examiner made statements (at page 6) which identified his own personal experience, and identified that he believed that his interpretation was consistent with what one of ordinary skill in the art would have interpreted the phrase "comparable sales" to have included.

Reply Brief filed August 15, 2006: Appellant, in response to the Examiner's Answer, alleged that the Examiner's statements had provided ambiguous rationale and had provided inadequate support in justifying that his interpretation of phrase "comparable sales" in Lough would have included both properties that are for sale and properties that have already sold. Further, Appellant questioned the source of the rationale as being derived from either or both of the Examiner's own knowledge and Official Notice of "comparable sales". In either case, Appellant requested clarification and evidence in support of such findings (by the provision of documentation and/or by Affidavit pursuant to 37 CFR. 1.04(d)(2)).

Supplemental Examiner's Answer mailed November 28, 2006: The Examiner, in response to the Reply Brief, provided clarification of his rationale and provided a definition of "comparables" from *Barrons Real Estate Guides, Dictionary of Real Estate Terms, second edition, 1987*) in support of his justification that his interpretation that the phrase "comparable sales" in Lough was consistent with what one of ordinary skill in the art would have interpreted the phrase "comparable sales" to have included.

#### Authority

37 CFR 41.43 states, in part, that:

"[T]he primary examiner...may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief" (emphasis added).

Additionally, MPEP 1207.05(I) states, in part, that:

"The examiner cannot issue a supplemental examiner's answer if the reply brief raises no new issue" (emphasis added).

#### Opinion

Although the Examiner characterized (at page 2) the filing of the Supplemental Examiner's Answer as being "compelled" due to the entry of a substantial number of "new arguments" in the Reply Brief, it is apparent that Appellant had directed such arguments to an issue first raised in the Reply Brief. That is, Appellant, in the Reply Brief has presented a new matter of dispute as to why the Board of Patent Appeals and Interferences should not sustain the Examiner's ultimate legal conclusion that the claims are unpatentable in view of Lough under 35 USC 103(a). This issue is not predicated

on the reason that the Examiner had misconstrued the meaning of the "phrase "comparable sales" in Lough (such as alleged in the Appeal Brief), but on the newly presented reasoning that the Examiner had not applied appropriate rationale in arriving at his interpretation of the phrase "comparable sales" in Lough and had not adequately justified the application of such interpretation.

Specifically, in the Reply Brief, Appellant alleged that although the Examiner had provided (in his Examiner's Answer) an indication that his interpretation of the phrase "comparable sales" included "sold properties" (at page 6), such interpretation, nonetheless, was considered inappropriate in application to the claimed subject matter because the Examiner had failed to demonstrate that he had applied an unambiguous rationale for arriving at his interpretation of such phrase and had failed to justify the application of his interpretation of the phrase "comparable sales" in Lough to the claimed subject matter.

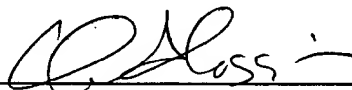
This issue, once raised, placed into dispute whether or not the Examiner had appropriately applied his interpretation of the phrase "comparable sales" in Lough to the claimed subject matter, and, consequently, placed into dispute his ultimate legal conclusion that the claims are unpatentable in view of Lough under 35 USC 103(a).

The Examiner, in filing the Supplemental Examiner's Answer, has merely responded to this new issue by providing both his specific rationale for arriving at his interpretation of the phrase "comparable sales" in Lough and by justifying that his rationale was consistent with what one of ordinary skill in the art would have interpreted the phrase "comparable sales" in Lough to have included (citing *Barrons*, supra ).

Accordingly, the Examiner's filing of a Supplemental Examiner's Answer in this case is permissible pursuant to both to 37 CFR 41.43 (a) and MPEP 1207.05(I) inasmuch as the Reply Brief has raised a new issue and inasmuch as the Supplemental Examiner's Answer was in response to a new issue raised in the Reply Brief.

#### Summary

The Petition is DENIED and the application is being electronically forwarded to the Board of Patent Appeals and Interferences for consideration of the appeal.

  
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wc/js: 05/21/2007

